

### REMARKS

Claims 1 to 19 are pending. Claims 1, 6 and 10-19 are rejected. Claims 2-5 and 7-9 are objected to. Claim 1 is hereby amended.

Claim 1 has been amended in part by removing the limitation: "wherein the grounding contact elements frictionally engage the grounding plate within the throughholes and the grounding contact element connects directly to the ground conductors of the cables or directly to the terminal connector of the cables." This limitation was added to claim 1 during the PCT prosecution to distinguish the claims from EP 0 311 041. However, Applicant believes that the limitation is not necessary to distinguish the claims as currently amended from this reference and, accordingly, rescind the limitation and retract all arguments relating thereto.

### § 102 Rejections

Claims 1, 6, 10-15 and 17-19 were rejected under 35 U.S.C. 102(b) as being anticipated by Shepherd (U.S. 5,997,348) (referred to hereinafter as "Shepherd").

The Office Action essentially states that:

In regard to claim 1, Shepherd discloses a connector shell for a multiple wire cable assembly having multiple ground conductors and signal conductors, the connector shell comprising: a housing 1 having a ground potential, a multitude of contact elements 34, 15 arranged in a longitudinal array, the contact elements being provided for making electrical contact to contact elements of a mating connector and comprising: grounding contact elements 34 for connecting to the ground conductors 8 of cables of the multiple wire cable assembly 4 and signal contact elements 15 for connecting to the signal conductors 6, 7 of the cables of multiple wire cable assembly 4, a longitudinal grounding plate 24 extending along and in the longitudinal direction of the array of the contact elements, the grounding plate 24 having two lateral edges at least one of which is provided for electrical connection to the ground potential of the housing 1, wherein the grounding plate 24 comprises throughholes 28 having the grounding contact elements 34 extending therethrough, and wherein the grounding contact elements 34 frictionally engage the grounding plate 24 within the through holes 28 and the grounding contact element 34 connects directly to the ground conductors 8 of the cables.

In regard to claim 6, Shepherd discloses the longitudinal array of the contact elements comprises at least one row of grounding contact elements 34 and at least one row of signal contact elements 15, the rows of grounding and signal contact elements 34, 15 being arranged adjacent to each other.

In regard to claim 10, Shepherd discloses the grounding contact elements 34 are frictionally received in the respective through holes 28 of the grounding plate 24 for making mechanical and electrical contact with the grounding plate 24 within the respective throughholes 28.

In regard to claim 11, Shepherd discloses at least the grounding contact elements 34 comprise grounding pins.

In regard to claim 12, Shepherd discloses the grounding pins 34 are designed as compliant pins.

In regard to claim 13, Shepherd discloses the grounding plate 24 comprises an electrically conductive layer.

In regard to claim 14, Shepherd discloses the electrically conductive layer 28 extends into the throughholes receiving the grounding pins 34.

In regard to claim 15, Shepherd discloses the grounding plate 24 is made from electrically conductive material, in particular metallic material.

In regard to claim 17, Shepherd discloses a socket connector 10 having a plurality of contact elements wherein each contact element comprises a contact pin 15 and a socket 28 for receiving a contact pin of a mating connector.

In regard to claim 18, the recitation "coaxial cables or twinaxial cables" has not been given a significant patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1 987).

In regard to claim 19, Shepherd discloses the contact elements 15, 28 are provided for receiving terminal connectors having a housing of electrically conductive material, at least one signal contact element arranged within the housing and electrically insulated relatively to the housing and electrically connected to a signal element of the array of contact elements and at least one ground contact element arranged within the housing as well as electrically connected thereto and electrically insulated relatively to the signal contact element of the housing and electrically connected to a grounding contact element of the array of contact elements.

Applicant respectfully submits that according to MPEP 2131 "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (citing *Verdegall Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Shepherd does not disclose "contact elements being provided for making direct electrical contact to contact elements of a mating connector and comprising: (i) grounding contact elements for connecting to the ground conductors of cables of the multiple wire cable assembly and (ii) signal contact elements for connecting to the signal conductors of the cables of multiple wire cable assembly" (emphasis added) as is required by the present claims. The ground contact pin (screening contact pins 34) of Shepherd do not make direct, or indirect, electrical contact with contact elements of a mating connector. Accordingly, the reference does not describe every element of the claimed invention.

For these reasons, Applicant submits that the cited reference will not support a 102(b) rejection of the claims and request that the rejection be withdrawn.

**§ 103 Rejections**

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shepherd (U.S. 5,997,348) in view of EP 0952637.

The Office Action essentially states:

Shepherd does not disclose that the housing 1 comprises a first half and a second half, at least the first housing half comprising an electrically conductive material, and wherein the grounding plate 24 along its grounded longitudinal edge mechanically and electrically contacts the first half.

EP 0 952 637 A1 discloses that the housing comprises a first half 3a and a second half 3b, at least the first housing half 3a comprising an electrically conductive material, and wherein the grounding plate 10a along its grounded longitudinal edge mechanically and electrically contacts the first half 3a.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shepherd's invention by constructing the housing as disclosed by EP 0 952 637 A1 in order to conveniently access the components within the housing when it is needed.

Applicant respectfully submits that according to MPEP 2142, to establish a case of *prima facie* obviousness, three basic criteria must be met: 1) there must be some suggestion or motivation, either in the references or generally known to one skilled in the art, to modify or combine reference teachings, 2) there must be reasonable expectation of success, and 3) the prior art references must teach or suggest all the claim limitations. The ability to modify the method of the references is not sufficient. The reference(s) must provide a motivation or reason for making the changes. *Ex parte Chicago Rawhide Manufacturing Co.*, 226 USPQ 438 (PTO Bd. App. 1984).

Applicant incorporates by reference their response, above, to the 102(b) rejection based on Shepherd. Applicant further submits that the combination of EP 0 952 637 with Shepherd, do not make up for the deficiencies of Shepherd as a prior art reference. Applicant respectfully submits that the references cannot support a case of *prima facie* obviousness as to claim 16 because, among other possible reasons, the cited references do not provide a motivation or suggestion for making the one piece housing of Shepherd into a two-piece housing as taught by EP 0 952 637. The Office Action states that "it would have been obvious . . . to modify Shepherd's invention by constructing the housing as disclosed by EP 0 952 637 in order to conveniently access the components within the housing when it is needed." However, Shepherd states at col. 3, lines 56-59: "The arrangement of the present invention has the advantage that

individual cables can be easily disconnected from the connector, such as for repair, without disturbing the grounding connection of other cables.” This language indicates that Shepherd recognizes that the housing can and will be easily removed. Accordingly, there would be no motivation to change the housing from one piece to two pieces, which would unnecessarily complicate the structure without adding any benefit.

For these reasons, Applicant submits that the cited references will not support a 103(a) rejection of the claims and request that the rejection be withdrawn.

In addition to the foregoing arguments, Applicant submits that a dependent claim should be considered allowable when its parent claim is allowed. *In re McCarn*, 101 USPQ 411 (CCPA 1954). Accordingly, provided the independent claims are allowed, all claims depending therefrom should also be allowed.

Based on the foregoing, it is submitted that the application is in condition for allowance. Withdrawal of the rejections under 35 U.S.C. 102(b) and 103(a) is requested. Examination and reconsideration of the claims are requested. Allowance of the claims at an early date is solicited.

The Examiner is invited to contact Applicant’s attorney if the Examiner believes any remaining questions or issues could be resolved.

Respectfully submitted,

March 21, 2007  
Date

By: Melanie Gover  
Melanie G. Gover, Reg. No.: 41,793  
Telephone No.: 512-984-4308

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833